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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,745	12/14/2006	Frank Konrad Doermier	3754	6453
278	7590	03/14/2008		
MICHAEL J. STRIKER 103 EAST NECK ROAD HUNTINGTON, NY 11743			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 03/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,745

Applicant(s)

DOERMER, FRANK KONRAD

Examiner

PRADEEP C. BATTULA

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23-27 is/are rejected.
- 7) ☒ Claim(s) 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: In line 5 the limitation of "the lower film layer has...the character string" is not of proper antecedent basis and should be changed to "a lower film layer having....a character string". Appropriate correction is required.

Claim 3 is objected to because of the following informalities: In line 4 the limitation of "the rubble layer", and in line 5 the limitation of "the unwritten edge" are if improper antecedent basis" Appropriate correction is required.

Claim 4 is objected to because of the following informalities: In line 3 the limitation of "the rubble paint layer" is of improper antecedent basis. Appropriate correction is required.

Claims 6, 23, and 24 – 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 places the printed image on a different side of the substrate than in Claim 5 and does not further limit the image on the front side of the substrate. Claim 27 is identical to Claim 7. Claim 23 is identical to Claim 3. It might be more appropriate to depend Claims 23 and 27 from Claim 18. Claim 24 is further objected to since it is dependent from Claim 23 and Claim 26 is further objected to as being dependent from Claim 25

Claim 20 is objected to because of the following informalities: The word "unwritten" in line 2 should be replaced with "uncoated". Appropriate correction is required.

Please review the application for other informal errors.

Double Patenting

Applicant is advised that should claims 1 - 3, or 7 be found allowable, claims 18, 19, 23 and 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 recites the limitations "the absorption layer" and in the last line. There is insufficient antecedent basis for this limitation in the claim. Nowhere in Claim 1 does applicant disclose the absorption layer and therefore the absorption layer being surrounded by an adhesive free frame cannot be addressed.

Claim 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1 the applicant claims the information/character string are between two labels but in Claim 3, discloses that an upper layer has the

information applied on it. With respect to the figures the information/character string is never on the upper layer. Furthermore the claim seems to recite that the upper layer further covers the information that is applied on it.

Claim Rejections - 35 USC § 103

1. Claims 1, 2, 3, 7, 18, 19, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grotzner et al. (Grotzner; U.S. 6,358,607) in view of Hill (U.S. 6,361,889).

In regards to Claims 1 and 18 (Claim 18 is identical to Claim 1), Grotzner discloses a security label for concealing information that is intended to be made known solely to an authorized user (Column 1, Lines 54 – 58; Column 2, Lines 23 – 28, 60 – 66); having an information string 2 that is to be concealed by an above label comprising adhesive 3, transparent base layer acting as an upper layer 4, scratch layer 5, and authentication mark 6 having its own security feature (Column 1, Lines 54 – 58; Column 2, Lines 60 – 66; Figure 1, Items 2 – 6).

Grotzner does not disclose that the information to be concealed is applied between two labels that each on their own and in cooperation have different security features the lower film layer has at least the size of the character string and is provided, at least in the region of the information to be concealed, with an interference field; the interference field has at least the layer thickness of the information to be applied; above the interference field, an upper layer is applied, on which the information can be applied, and the upper layer has at least the size of the character string.

Hill discloses a security article having lower film layer 46 having at least the size of a character string 60, 62 (Column 4, Lines 62 – 67 → Column 5, Lines 1 – 7, 56 – 63; Figure 4, Items 46, 60, 62) and is provided, at least in the region of the information, with an interference field 44 (Column 5, Lines 1 – 7; Figure 4, Item 44); the interference field has at least the layer thickness of the information to be applied (Figure 4, Items 44, 46, 60, 62); above the interference field, an upper layer 64, 68 is applied (Column 5, Lines 64 – 67 → Column 6, Line 1, 11 – 16), on which the information can be applied, and the upper layer has at least the size of the character string (Figure 4, Items 64, 68, 62, 60). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Grotzner with tamper indicia below the information string in order to provide additional tamper elements to the concealing label.

In regards to Claims 2 and 19 (Claim 19 is identical to Claim 2), as applied to Claims 1 and 18, Grotzner modified by Hill further discloses that around the field for the information, an uncoated frame out of the substrate film remains free (Column 3, Lines 39 – 43; Figures 2 & 3, Items 2, 3 – uncoated substrate around information; Grotzner discloses such an embodiment can exist).

In regards to Claims 3 and 23, as applied to Claims 1 and 18, Grotzner modified by Hill further discloses that the upper layer on which an information is applied (Figure 8, Item 6 shows information; Grotzner) is designed to be so large that an uninscribed edge without information is created (Column 6, Lines 5 – 7; Column 50 – 67; Column 7, Lines 24 – 38; Figure 8, Item 6 – information is not at an edge; Figure 7, Item 4), wherein the upper layer further covers information 2 the entire information surface by a

rubble layer 6 (Column 3, Lines 5 – 9; Figure 7, Item 6) and the unwritten edge is covered by a void film (5, 9 – 11) on both sides of the upper layer (Column 1, Lines 54 – 58; Column 6, Lines 50 – 67; Figure 7, Items 5, 6, and 9 – 11; Grotzner).

In regards to Claim 7 and 27, as applied Claims 1 and 18, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

2. Claims 4 – 6, 24 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grotzner in view of Hill and Gunderson et al. (Gunderson; U.S. 3,638,335).

In regards to Claims 4 and 24, as applied to Claims 1 and 18, Grotzner modified by Hill further discloses that a printed image (Figure 8, Item 6; Grotzner) in the form of graphic patterns and/or characters is applied to the rubble paint layer 6 (Column 3, Lines 5 – 9; Grotzner).

Grotzner modified by Hill does not disclose at least in the region of this layer by means of a reagent ink which is indirectly or directly visible.

Gunderson discloses of a writing fluid, which the examiner considers ink since it is used for writing, having ink and a reagent which upon a treatment becomes viewable to an individual (Column 4, Lines 26 – 38). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide at

least some indicia of Grotzner modified by Hill with a reagent ink in order to provide a security feature where indicia appears upon a treatment.

In regards to Claims 5 and 25, as applied to Claims 1 and 18, Grotzner modified by Hill further discloses that a printed image 2 is applied to the front side in the form of graphic patterns and/or characters on the background (substrate medium) on which the lower label is applied (Column 2, Lines 60 - 61; Figure 7, Item 2).

Grotzner modified by Hill does not disclose the information is of reagent ink which is indirectly or directly visible.

Gunderson discloses of a writing fluid, which the examiner considers ink since it is used for writing, having ink and a reagent which upon a treatment becomes viewable to an individual (Column 4, Lines 26 – 38). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide at least some indicia of Grotzner modified by Hill with a reagent ink in order to provide a security feature where indicia appears upon a treatment.

In regards to Claims 6 and 26, as applied to Claims 5 and 25, Grotzner modified by Hill and Gunderson discloses the claimed invention except for the printed image is applied to the back side of the background (substrate medium). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide information on both sides of the substrate because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

3. Claims 8 - 12, 15, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Grotzner in view of Buck (U.S. 5,851,614).

Grotzner discloses a security label for concealing information applied to a medium of a variable kind, such as plastic cards, paper and the like, which information is intended to be made known solely to an authorized user (Column 1, Lines 54 – 58; Column 2, Lines 23 – 28, 60 - 66), in which the label comprises at least one substrate layer 1 (Column 2, Lines 60 – 62; Figure 1, Item 1) that comprises an upper layer 4 (Column 2, Lines 64 – 66; Figure 1, Item 4) and an adhesive layer 3 located beneath the upper layer (Column 2, Lines 60 – 62; Figure 1, Item 3), an information field 2 (Column 2, Line 60; Figure 1, Item 2).

Grotzner does not disclose that an absorption layer is applied on the underside of the adhesive layer in such a way that the absorption layer has a greater extent than the information field to be concealed and at least completely covers it and is smaller than the substrate layer, and this absorption layer is a parting layer between the covering adhesive layer and the information layer.

Buck discloses of a UV absorbing layer 42 provided underneath an adhesive 54 while separating the adhesive from ink layers 38 on top of a substrate 40 and further having another adhesive 48 layer below. (Column 5, Lines 32 – 38, 50 – 52; Figure 4, Items 38, 40, 42, 48, 54). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a UV absorbing layer to the security label of Grotzner in order to prevent one from using light (candling

type method) to review the concealed material and also protecting the concealed information from damage.

In regards to Claim 9, as applied to Claim 8, Grotzner modified by Buck further discloses the upper layer is designed as a transparent film (Column 2, Lines 64 – 66; Grotzner); that on the substrate layer there is a so-called rubble field 5 (Column 2, Lines 66 – 67 → Column 3, Lines 1 – 5; Figure 1, Item 5; Grotzner shows it is on the substrate since it is on layers which are on the substrate), which covers the information from above (Figure 1, Items 2, 5). Grotzner modified by Buck discloses the claimed invention except for the absorption layer comprises a transparent film. Applicant has failed to disclose the criticality of the absorption layer being opaque or transparent. Therefore it would have been obvious to a person having ordinary skill in the art to provide a transparent absorbing layer because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *See also In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claim 10, as applied to Claim 9, Grotzner modified by Buck further discloses that an adhesive layer is located under the absorption layer (Column 5, Lines 32 – 38, 50 – 52; Buck discloses two adhesive one above and one below the absorption layer). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In regards to Claim 11, as applied to Claim 8, Grotzner modified by Buck further the upper layer may comprise a film or so-called void film (5, 6, 9 – 11) (Column 1, Lines 54 – 58; Column 6, Lines 50 – 67; Figure 7, Items 5, 6, and 9 – 11; Grotzner discloses that an embodiment with void film while maintaining all previous components). Grotzner modified by Buck discloses the claimed invention except for the absorption layer comprises a opaque film. Applicant has failed to disclose the criticality of the absorption layer being opaque or transparent. Therefore it would have been obvious to a person having ordinary skill in the art to provide an opaque absorbing layer because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *See also In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claim 12, as applied to Claim 11, Grotzner modified by Buck further discloses that an adhesive layer is located under the absorption layer (Column 5, Lines 32 – 38, 50 – 52; Buck) and involves an adhesive of the kind which when the label is peeled off does not destroy the information layer (Figure 8; Grotzner).

In regards to Claim 15, as applied to Claim 11, Grotzner modified by Buck further discloses that the absorption layer itself is embodied as a so-called interference field (Column 5, Lines 54 – 65; Buck; The Examiner considers the absorption layer an interference field since it absorbs UV rays it is interfering with the other layers).

In regards to Claim 16, as applied to Claim 15, Grotzner modified by Buck further the upper layer may comprise a film or so-called void film (5, 6, 9 – 11) (Column 1, Lines 54 – 58; Column 6, Lines 50 – 67; Figure 7, Items 5, 6, and 9 – 11; Grotzner

discloses that an embodiment with void film while maintaining all previous components). Grotzner modified by Buck discloses the claimed invention except for the absorption layer comprises a opaque film. Applicant has failed to disclose the criticality of the absorption layer being opaque or transparent. Therefore it would have been obvious to a person having ordinary skill in the art to provide an opaque absorbing layer because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *See also In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

4. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grotzner in view of Buck and Hill.

Grotzner modified by Buck does not disclose the absorption layer is provided with a further layer located under it that is embodied as a so-called interference field, which comprises statistically randomly distributed fragments of characters and/or serpentine lines and/or similar patterns.

Hill discloses a security article having lower film layer 46 having at least the size of a character string 60, 62 (Column 4, Lines 62 – 67 → Column 5, Lines 1 – 7, 56 – 63; Figure 4, Items 46, 60, 62) and is provided, at least in the region of the information, with an interference field 44 (Column 5, Lines 1 – 7; Figure 4, Item 44); the interference field has at least the layer thickness of the information to be applied (Figure 4, Items 44, 46, 60, 62); above the interference field, an upper layer 64, 68 is applied (Column 5, Lines 64 – 67 → Column 6, Line 1, 11 – 16), on which the information can be applied, and the upper layer has at least the size of the character string (Figure 4, Items 64, 68, 62, 60).

Hill further discloses the interference field comprises statistically randomly distributed fragments of characters and/or serpentine lines and/or similar patterns (Column 3, Lines 36 – 51). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Grotzner modified by Buck with tamper indicia below the information string in order to provide additional tamper elements to the concealing label.

In regards to Claim 14, as applied to Claim 13, Grotzner modified by Buck and Hill further disclose that a further adhesive layer is located under the interference field (Column 5, Lines 32 – 38, 50 – 52; Buck has adhesives above and below [near substrate]) and involves an adhesive of the kind that when the label is peeled off does not destroy the information layer (Figure 8; Grotzner).

Allowable Subject Matter

Claims 20 – 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations and correcting any errors of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3722
February 27, 2008

/Monica S. Carter/

Supervisory Patent Examiner, Art Unit 3722